

REMARKS

Claims 25-32 are pending in the application.
Claims 1-24 and 33-34 had been earlier cancelled without prejudice.
Claim 32 has been amended to correct minor informalities.
No new matter has been added.
Reconsideration of the Claims is respectfully requested.

Applicant notes with appreciation the Telephonic Interview with the Examiner on March 17, 2006, regarding changes and/or modifications to Applicant's Claims that the Examiner indicated would aid in distinguishing Applicant's claimed invention in view of the Examiner's cited references, and such amendments had been presented, as discussed, for consideration by the Examiner and for allowance of the case.

The Final Office Action had stated that such amendments were not persuasive as a mobile station may be either a calling terminal or a called terminal; however, Applicant respectfully submits that the cited references cited do not support such juxtaposition. Further, Applicant respectfully submits that its claimed invention of Independent Claim 25 and Independent Claim 28 are drawn to a "mobile station of a calling party," and that that claimed invention of Independent Claim 32 is drawn to a "method for connecting a call placed by a calling party to a called party having a multi-line capable phone." Reconsideration of the claims is respectfully requested.

1. Claim Rejections under 35 U.S.C. § 112, ¶ 2

Claim 32 was rejected as lacking antecedent basis for "second call." Appropriate correction has been made.

2. Claim Rejections under 35 U.S.C. § 103(a)

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142, p. 2100-134 (Rev. 3, May 2005) (citations omitted).

a. Claims 25 and 27 were rejected under 35 USC § 103(a) as being unpatentable over US Patent No. 6,393,272 ("Cannon") in view of US Patent No. 6,633,634 ("Crockett") and US Patent No. 6,665,375 ("Forlenza").

b. Claim 26 was rejected under 35 USC § 103(a) as being unpatentable over Cannon in view of Crockett, Forlenza, and US Patent No. 6,606,505 ("Chow"). Applicant respectfully traverses this rejection.

c. Claims 28-31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Cannon in view of Crockett.

d. Claims 32 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Chow in view of Forlenza. Applicant respectfully traverses this rejection.

Generally, the hypothetical combination of Cannon in view of Crockett had been cited as the references in the rejection of Applicant's Claims 25 through 31, with the addition of Forlenza and/or Chow cited in view of elements absent in Cannon and/or Crockett. The hypothetical combination of Chow in view of Forlenza had been cited in the rejection of Applicant's Independent Claim 32.

Cannon recites a system with a "controller 109 [that] will respond to a signal from Answer & Hold input element 121 of input unit 107 to answer an incoming call, cause the outgoing message unit 119 to output a particular outgoing message, and maintain a connection status of the incoming call." (Cannon 2:22-27). The Final Office Action noted that Cannon "does not specifically mention prompting a called party to take the call after a specified period of time" (Final Office Action at p. 2-3).

Crockett recites a caller-while-waiting ID "system 10 [that] enables a customer at the called communication station 30, who is busy on a previous call, to be efficiently and effectively notified that a current call from calling communication station 40 is waiting. The system 10 provides an enhanced call waiting message that includes both the call waiting indicator and the audible representation of information associated with the calling communication station 40." (Crockett 2:51-58). The called party is provided "with information that assists the [called party] in deciding whether to take the current call." (Crockett 2:65-67). That is, Crockett is a call waiting system, which "generally notif[ies] a [called party] that is busy on a previous call that a current call has been placed to the customer," (Crockett 1:14-17), but does not answer the call from the mobile station of a calling party. The calling party has no input to, nor feedback from, the called party.

Forlenza recites a "telephone with a customized display for displaying call connection status information . . . such as ringing and busy signals, and presents the call status via a status indicator." (Forlenza 1:42-47). Through Forlenza was cited for a voice response system, such systems being "an automated telephone answering system that responds with a voice menu and allows the user to make choices and enter information via the keypad or spoken input. IVR systems are widely used in call centers as well as a replacement for human switchboard operators." (Forlenza 3:32-16). Forlenza does not discuss placing incoming calls on hold.

Chow recites a “wireless centrix system (WCS) that allows a subscriber to use the same standard cellular/PCS telephone in both the wireless centrix system domain as well as the public cellular system domain. In the WCS domain, subscribers can use their cellular PCS as a cordless-like phone without incurring air-time charges. The WCS has the advantage of providing a working environment mobile telephone system having traditional centrex and PBX type services such as call waiting, call hold, call forwarding, caller ID, three party conference calling, and call messaging.” (Chow 2:29-38). That is, the centrix system of Chow provides some landline services in a cellular network.

Applicant respectfully submits that the motivation or suggestion in the cited references stems from Applicant’s own specification. The Federal Circuit has noted that “an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be ‘an illogical and inappropriate process by which to determine patentability.’” *In re Rouffett*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (quoting *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570 (Fed. Cir. 1996)). “To prevent the use of hindsight based on the invention to defeat patentability of the invention, [the Federal Circuit] requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” *In re Rouffett* at 1357.

Applicant respectfully submits that the cited references do not provide every element of Applicant’s claimed invention, and further that “prior art corollaries” from the cited references are improperly relied upon in the rejection, and that a *prima facie* case of obviousness had not been established. Further, the hypothetical combination of the cited references does not teach or suggest all the claim limitations.

For example, Applicant’s Independent Claim 25 recites, *inter alia*, a “mobile station, comprising: communication circuitry for processing wireless communication signals; audio processing circuitry for converting between sound and audio signal and for receiving sound from a microphone and for producing sound to a speaker; logic to prompt the mobile station to generate signaling to a communication network element to complete call setup including completing connection of a voice channel and further to mute the microphone even though the voice channel is connected; logic to prompt the mobile station to prompt

a called party to take the call after a specified period of time as a reminder that a calling party is on hold. . . .” (emphasis added).

Applicant’s Independent Claim 28 recites, *inter alia*, a “mobile station, comprising: . . . audio processing circuitry for converting between sound and audio signal and for receiving sound from a microphone and for producing sound to a speaker; logic to prompt the mobile station to prompt a called party to take the call after a specified period of time has elapsed as a reminder that a calling party is on hold; and logic circuitry for prompting the mobile station to complete call connection including the voice channel and further to mute the microphone until the called party takes the call to prevent audio transmission over the voice channel until the called party takes the call” (emphasis added).

As noted above, the hypothetical combination of Chow in view of Florenza was submitted in the rejection of Applicant’s Independent Claim 32. Chow is a wireless centrix system to provide some landline features to a cellular PCS network. Florenza is a voice response device. Applicant respectfully submits that the cited references of Chow and Florenza do not provide every element of Applicant’s claimed invention, and further that “prior art corollaries” from these cited references are improperly relied upon in the rejection, and that a *prima facie* case of obviousness had not been established. Further, the hypothetical combination of the cited references does not teach or suggest all the claim limitations.

For example, Applicant’s Independent Claim 32 recites, *inter alia*, a “method for connecting a call placed by a calling party to a called party having a multi-line capable phone, comprising: . . . receiving an indication from the called party to place the calling party on hold; responding to a called party indication by triggering an IVR to play a select message to the calling party to advise the calling party that the called party will be taking the call shortly; and when a specified period of time has elapsed, providing, on behalf of the calling party, a reminder to the called party that the second call first call is still on hold.” (emphasis added).

Applicant respectfully submits that there is no suggestion or motivation in the cited references to modify or combine the caller-on-hold device of Cannon, with the call waiting device of Crockett, with the IVR device of Forlenza to achieve Applicant’s claimed invention of Independent Claim 25 and Claims 26 and 27 that depend therefrom, of Independent Claim 28 and Claims 29-31 that depend directly or indirectly therefrom, or of Independent Claim 32. Further, the hypothetical combination of the cited references does not teach or suggest all the claim limitations. Accordingly, Applicant respectfully requests that the rejection to Claims 25 through 32 be withdrawn.

3. Conclusion

As a result of the foregoing, the Applicant respectfully submits that Claims 25-32 are in condition for allowance, and respectfully requests an early allowance of such Claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at ksmith@texaspatents.com.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Garlick Harrison & Markison Deposit Account No. 50-2126 (ref. 11271STUS01U).

Respectfully submitted,

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